




# UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/817,456  | 04/02/2004  | Geoffrey B. Rhoads   | P0965               | 1643             |
| 23735   | 7590        | 12/17/2004           | EXAMINER            |                  |
| DIGIMARC CORPORATION<br>9405 SW GEMINI DRIVE<br>BEAVERTON, OR 97008 |             |                      | LABAZE, EDWYN       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2876                |                  |

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                     |   |
|------------------------------|-------------------------------|-------------------------------------|---|
| <b>Office Action Summary</b> | Application No.<br>10/817,456 | Applicant(s)<br>RHOADS, GEOFFREY B. |   |
|                              | Examiner<br>EDWYN LABAZE      | Art Unit<br>2876                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-17 are presented for examination.
2. This application is a continuation of 10/717,211 filed on 11/18/2003, which a continuation of application # 09/342,688 filed on 06/29/1999 (now U.S. 6,650,761), which is a CIP of application # 09/314,648 filed on 5/19/1999 (now U.S. 6,681,028) and claims the benefits of provisional application # 60/134,782 filed on 05/19/1999.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-3, 5-6, 10-11, 15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Rothschild (U.S. 6,651,053).

Re claims 1 and 15: Rothschild discloses interactive system for investigating products on a network, which includes using a handheld appliance [herein described a

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mobile device 20, e.g. a laptop computer or PDA] (as shown in fig. # 1; col.7, lines 22+), receiving digital data [herein broadly interpreted as a barcode] from the poster [or a package or advertisement]; and by reference to the data received from the poster, establishing a link to a remote computer 12 (col.7, lines 37-67; col.8, lines 1-53).

Re claim 2: Rothschild teaches a system and method, wherein the appliance 20 is a wireless device [personal digital assistant/PDA] (col.7, lines 42+).

Re claim 3: Rothschild discloses a system and method, wherein the appliance 20 comprises a computer (col.7, lines 47+).

Re claims 5-6: Rothschild discloses a system and method, wherein the appliance 20 includes an output device [such as a display/screen with means of outputting the digital data/image, text, and or video of the scanned product], and the method includes presenting information to a user based on data obtained from the remote computer using the output device, and wherein the output device includes a screen (see fig. # 1; col.8, lines 1+).

Re claim 10: Rothschild teaches a system and method, further includes communicating over the link to cause electronic content to be downloaded to a user of the appliance (col.8, lines 35+; col.9, lines 60+).

Re claim 11: Rothschild discloses a system and method, wherein the electronic content comprises a song (col.6, lines 55+).

Re claim 17: Rothschild teaches a system and method, wherein the appliance comprises a cell phone [or a wireless internet phone] (col.4, lines 8+; col.7, lines 45+).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (U.S. 6,651,053) in view of Ausems et al. (U.S. 6,434,403).

The teachings of Rothschild have been discussed above.

Rothschild fails to teach a portable device with a camera and an annunciator.

Ausems et al. teaches personal digital assistant 100 with wireless telephone, which includes a camera 190 and an annunciator/speaker 135/185 (col.5, lines 10+).

In view of Ausems et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a camera and an annunciator/speaker into the teachings of Rothschild so as to capture a picture/image and enable means of announcing input/output signals. Furthermore, the intended use of scanning an image/barcode from a package or advertisement is functionally equivalent as of taking a snapshot of the image using a camera coupled to the portable device, and wherein most scanners in the art include a camera/CCD. Moreover, such modification would have been an obvious extension as taught by Rothschild, therefore an obvious extension.

7. Claims 8-9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (U.S. 6,651,053) in view of Tarbouriech (U.S. 6,674,993).

The teachings of Rothschild have been discussed above.

Rothschild fails to teach a poster for promoting a ticketed event, such as a concert or movie.

Tabouriech discloses method and system for identifying data locations associated with real world observations, which includes poster for promoting ticketed event for concert or movie (col.12, lines 13-14).

In view of Tabouriech's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a poster into the teachings of Rothschild for promoting ticketed event for concert or movie. Furthermore, such modification would enable the user to investigate and/or contemplate purchasing of a product by scanning [as taught by Rothschild] or taking a snapshot of a code/image associated with the poster/advertisement, and linking [via a wireless transmission over the internet] the decoded digital data/image from the scanned barcode with a website associated with the image. Moreover, such modification would have been an obvious modification as taught by Rothschild, therefore an obvious expedient.

8. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (U.S. 6,651,053) in view of Gabbard et al. (U.S. 6,205,432).

The teachings of Rothschild have been discussed above. Rothschild further discloses a wireless transmission path (col.4, lines 13+; col.7, lines 48+).

Rothschild fails to teach means of using electromagnetic communications, optical sensing, and printing that includes a plural-bit code steganographically encoded therein.

Gabbard et al. discloses background advertising system, which includes means of using electromagnetic communications, optical sensing (col.8, lines 25+), and printing

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that includes a plural-bit code steganographically [also known in the art as a digital watermark] encoded therein (col.4, lines 7+).

In view of Gabbard et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ means of using electromagnetic communications, optical sensing, and printing that includes a plural-bit code steganographically/watermark encoded therein into the teachings of Rothschild as a means of transmitting/receiving the code/image from the poster. Furthermore such modification would provide more ways of transferring data among the modules/ports, and means of embedded codes printed onto the poster/advertisement, which relates/directs to specific website or internet address for promotional considerations. Moreover, such modification would have been an obvious extension as taught by Rothschild, therefore an obvious expedient.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rothschild (U.S. 6,766,363) teaches system and method of linking items in audio, visual, and printed media to related information stored on an electronic network using a mobile device.

Boncyk et al. (US 2002/0090132) discloses image capture and identification system and process.

Prueitt et al. (US 2002/0184302) teaches method and system for generating a permanent record of a service provided to a mobile device.

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Hasegawa et al. (US 2003/0083937) discloses advertisement delivery systems, advertisement content and advertisement delivery apparatus and methods.

Henrick (US 2003/0060157) teaches purchase and delivery of digital content using multiple devices and data networks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
December 8, 2004



**THIEN M. LE  
PRIMARY EXAMINER**